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FULWIDER PATTON LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE, TENTH FLOOR LOS ANGELES, CA 90045			EXAMINER TRUONG, KEVIN THAO	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM J. BOYLE, BENJAMIN C. HUTER, CHARLES R.
PETERSON, DONALD E. SCHWARTEN, and RICHARD S. STACK

Appeal 2009-006121
Application 10/662,697
Technology Center 3700

Before: STEFAN STAICOVICI, PHILLIP J. KAUFFMAN, and
WILLIAM V. SAINDON, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 35-74. Claims 1-34 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

Claim 35, reproduced below with added emphasis, is illustrative of the claimed subject matter.

35. A system for recovering an embolic protection device which includes a guide wire and expandable filter disposed thereon from a body vessel, comprising:

- an inner catheter having a distal portion and a proximal end and being moveable along the guide wire, the distal portion including a length of flexible tubing;

- a control handle attached to the proximal end of the inner catheter;

- a recovery sheath having a distal end and a proximal end;
- and

- a control handle attached to the proximal end of the recovery sheath, wherein the inner catheter is capable of being loaded inside the recovery sheath with the distal portion of the inner catheter extending distally beyond the distal end of the recovery sheath when the inner catheter and recovery sheath are being advanced along the guide wire for placement in proximity to the expandable filter of the embolic protection device, the recovery sheath having sufficient column strength to collapse the expandable filter when advanced over the expandable filter *and the distal portion of the inner catheter has sufficient length to allow the distal end of the recovery sheath to track thereover to reduce the possibility that the recovery sheath will straighten the body vessel when deployed in a curved portion of the body vessel.*

References

The Examiner relies upon the following prior art references:

Heyn	US 5,201,757	Apr. 13, 1993
Daniel	US 6,171,327 B1	Jan. 9, 2001

Rejections

- I. Claims 35-40, 42-50, and 52-74 are rejected under 35 U.S.C. § 102(e) as anticipated by Daniel.
- II. Claims 41 and 51 are rejected under 35 U.S.C. § 103(a) as unpatentable over Daniel and Heyn.
- III. Claim 38 is rejected under 35 U.S.C. § 103(a) as unpatentable over Daniel.

SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND of REJECTION.

OPINION

The main dispute in this case is whether Daniel describes an inner catheter (inner member 172) with “sufficient length to allow the distal end of the recovery sheath to track thereover to reduce the possibility that the recovery sheath will straighten the body vessel when deployed in a curved portion of the body vessel,” as required by independent claims 35, 45, 54, and 68. *See* Appeal Br. 12-13; Ans. 7-9. Appellants argue that the inner catheter in Daniel is not capable of meeting the requirement of being a “sufficient length” to achieve the function of reducing the possibility of straightening a vessel. Reply Br. 6 (“the term ‘sufficient length’ [means a distal portion of a catheter] must be long enough to achieve this function”).

Thus, Appellants' argument begs the question of what length is "sufficient" to reduce the possibility of straightening a vessel. *See Seattle Box Co., Inc. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984) (when a term of degree is used it is necessary to determine whether there is some standard for measuring that degree). If the language of a claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. § 112, second paragraph, is appropriate.

Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986); *see Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005) ("Some objective standard must be provided in order to allow the public to determine the scope of the claimed invention.").

The distal portion of an inner catheter's length is "sufficient," according to the claims, if it satisfies the function of "reduc[ing] the possibility ... [the] sheath will straighten the body vessel." Thus, as suggested by Appellants, the claims' point of novelty lies within functional language. *See Halliburton Energy Serv., Inc., v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008) ("a vice of functional claiming occurs ... 'when ... conveniently functional language [is used] at the exact point of novelty.'") (*citing General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 371 (1938)). In this case, the claims do not describe what structure(s) is necessary to satisfy the claimed function. Therefore, we turn to the Specification. *See Orthokinetics, Inc.*, 806 F.2d at 1576 (the test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification") (citations omitted); *Halliburton*, 514 F.3d at

1255-56 (discussing various ways the specification may “resolve the ambiguities of a functional limitation”).

Appellants cite to paragraph 28 of the Specification as providing support for this portion of the claims. *See* Appeal Br. 8-10. However, reviewing the Specification, we do not find any discussion about a “sufficient length” for the distal end of the inner catheter, let alone a “sufficient length to allow the distal end of the recovery sheath to track thereover to reduce the possibility that the recovery sheath will straighten the body vessel when deployed in a curved portion of the body vessel.” Therefore, the Specification does not resolve the ambiguities of the claim. In fact, we instead find that the Specification describes the *stiffness* and *flexibility* of the inner catheter as helping to reduce straightening. Spec. 28; *see also* Appeal Br. 7 (noting the summary of claimed subject matter describes stiffness and flexibility as affecting straightening, not length).

Furthermore, the Specification does not provide a standard for determining the amount of stiffness and/or flexibility that reduces straightening, nor does the Specification provide a metric for determining what “reduc[ing] the possibility” amounts to, or even what amount of straightening is allowable. Indeed, a person has variously-sized vessels in his or her body, with various curvatures and physical characteristics – all of which may differ from person to person. Thus, a wide range of factors could affect whether a particular length may be sufficient to “reduce the possibility” of straightening. “When a proposed construction requires that an artisan make a separate infringement determination for every set of circumstances in which the [invention] may be used, and when such determinations are likely to result in differing outcomes (sometimes

Appeal 2009-006121
Application 10/662,697

infringing and sometimes not), that construction is likely to be indefinite.”
Halliburton, 514 F.3d at 1254-55.

In light of the above, we find that independent claims 35, 45, 54, and 68 are indefinite because there is no sufficient basis to evaluate whether a particular distal end of an inner catheter has a “sufficient length” as required by the claims. *See Orthokinetics*, 806 F.2d at 1576; *Datamize*, 417 F.3d at 1350. Because the limitation is indefinite, the Examiner’s rejections under §§ 102 and 103 must fall because they are necessarily based on a speculative assumption as to the meaning of the claims. *In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), for the reasons outlined above, we make the following new ground of rejection:

Claims 35-74 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

DECISION

We reverse the Examiner’s decision regarding claims 35-74. We enter new grounds of rejection for claims 35-74.

FINALITY OF DECISION

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of

Appeal 2009-006121
Application 10/662,697

rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner....

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record....

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. § 41.50(b)

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